

**REMARKS**

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-21 were pending in the application, of which Claims 1 and 14 are independent. In the Office Action dated October 20, 2004, Claim 19 was objected to as having an informality, Claims 1, 2, and 10-12 were rejected under 35 U.S.C. §102(b), Claims 1, 3, 4, 8, and 11 were rejected under 35 U.S.C. §102(e), and Claims 2, 14-17, 19, and 21 were rejected under 35 U.S.C. §103(a). Claims 5-7, 9, 13, 18, and 20 were objected to, but were deemed allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Following this response, Claims 1-21 remain in this application. Applicants hereby address the Examiner's rejections in turn.

I. Change to Attorney Docket Number

Please note that the Attorney Docket Number for this application is now **09242.0180-00**.

II. Objection to the Claims

In the Office Action dated October 20, 2004, the Examiner objected to Claim 19 as containing an informality. Claim 19 has been amended to address this informality and does not narrow the claimed subject matter. Applicants respectfully submit that the amendment overcomes this objection and adds no new matter.

III. Rejection of the Claims Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner rejected Claims 1, 2, and 10-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,101,304 ("*Quistorff*").

Applicants respectfully traverse this rejection.

Claim 1 is patentably distinguishable over the cited art in that it recites, for example, "a central strength member" and "a buffer tube stranded around the central strength member, the buffer tube loosely housing at least one optical fiber."

In contrast, *Quistorff* at least does not disclose a central strength member. For example, *Quistorff* discloses strength elements 16 on the periphery and not at the center. Moreover, while *Quistorff* discloses a central innerduct, this innerduct is not a central strength member. In *Quistorff*, a central strength member is not disclosed, rather a central innerduct 12 with peripheral strength elements 16 is.

*Quistorff* does not anticipate the claimed invention because *Quistorff* at least does not disclose a central strength member, as recited by Claim 1. Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claim 1.

Furthermore, Applicants respectfully suggest that the Examiner has failed to make a *prima facie* case of anticipation. In order to make a *prima facie* case of anticipation, the Examiner must set forth prior art which teach or suggest every claim limitation. As admitted by the Examiner, there is nothing in the prior art cited by the Examiner that discloses "a buffer tube stranded around the central strength member, the buffer tube loosely housing at least one optical fiber", as recited by Claim 1. (See Office Action, page 2, fourth line from the bottom.) Accordingly, independent Claim 1

patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claim 1.

If the Examiner continues to rely on this unsupported contention, Applicants respectfully request the Examiner to provide support. See, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

Dependent Claims 2-13 are also allowable at least for the reasons above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 2 and 10-12.

IV. Rejection of the Claims Under 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejected Claims 1, 3, 4, 8, and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2003/0035635 ("*Chastain*"). Claim 1 has been amended, and Applicants respectfully submit that the amendment overcomes this rejection and adds no new matter.

Amended Claim 1 is patentably distinguishable over the cited art in that it recites, for example, "a buffer tube stranded around the central strength member, the buffer tube loosely housing at least one optical fiber placed in the buffer tube precedent to an installation of the cable" and "a first conduit configured to receive at least one first blown optical fiber subsequent to the installation of the cable and positioned external to the central strength member."

In contrast, *Chastain* at least does not disclose the aforementioned recitation of amended Claim 1. For example, *Chastain* discloses an air blown fiber tube cable having improved thermal stability. Nowhere does *Chastain* disclose an optical fiber placed in a buffer tube precedent to an installation of the cable. Furthermore, *Chastain* does not disclose a first conduit configured to receive at least one first blown optical fiber subsequent to the installation of the cable. *Chastain* does not disclose fibers being placed in any of the disclosed tubes, much less fibers being placed in the disclosed tubes subsequent or precedent to the installation of a cable housing the tubes.

*Chastain* does not anticipate the claimed invention because *Chastain* at least does not disclose the aforementioned recitations of amended Claim 1. Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claim 1.

Furthermore, Applicants respectfully suggest that the Examiner has failed to make a *prima facie* case of anticipation. As stated above, in order to make a *prima facie* case of anticipation, the Examiner must set forth prior art which teach or suggest every claim limitation. As admitted by the Examiner, there is nothing in the prior art cited by the Examiner that discloses "a buffer tube stranded around the central strength member, the buffer tube loosely housing at least one optical fiber", as recited by Claim 1. (See Office Action, page 3, fourth line from the bottom.) Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 1.

If the Examiner continue to rely on this unsupported contention, Applicants respectfully request the Examiner to provide support. See, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the

Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

Dependent Claims 2-13 are also allowable at least for the reasons above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 2-13.

V. Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 14, 16, 17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Chastain* in view of U.S. Patent No. 5,046,815 ("*Cain*"). Applicants respectfully traverse this rejection.

Claim 14 is patentably distinguishable over the cited art in that it recites, for example, "a first conduit configured to receive at least one first blown optical fiber subsequent to the installation of the cable and positioned external to the central strength member" and "a conductor of electrical energy stranded around the central strength member."

In contrast, *Chastain* at least does not disclose the aforementioned recitations of Claim 14. As stated above for example, *Chastain* discloses an air blown fiber tube cable having improved thermal stability. Nowhere does *Chastain* disclose an optical fiber placed in a buffer tube precedent to an installation of the cable. Furthermore, *Chastain* does not disclose a first conduit configured to receive at least one first blown optical fiber subsequent to the installation of the cable. *Chastain* does not disclose fibers being placed in any of the disclosed tubes, much less fibers being placed in

disclosed tubes subsequent or precedent to the installation of a cable housing the tubes. Moreover, nowhere in *Chastain* does it disclose or suggest a conductor of electrical energy.

Furthermore, *Cain* does not overcome *Chastain*'s deficiencies. *Cain* merely discloses a telecommunications cable. Like *Chastain*, *Cain* at least does not teach or suggest "a first conduit configured to receive at least one first blown optical fiber subsequent to the installation of the cable and positioned external to the central strength member." Moreover, like *Chastain*, *Cain* at least does not teach or suggest a conductor of electrical energy. Instead, *Cain* discloses a copper twisted pair for telecommunications, not an energy conductor. (See col. 6, lines 20-22.)

Combining *Chastain* with *Cain* would not have led to the claimed invention because *Chastain* and *Cain*, either individually or in any reasonable combination, at least do not disclose or suggest "a first conduit configured to receive at least one first blown optical fiber subsequent to the installation of the cable and positioned external to the central strength member", as recited by Claim 14. Nor does *Chastain* and *Cain*, either individually or in any reasonable combination, disclose or suggest "a conductor of electrical energy stranded around the central strength member", as recited by Claim 14. Accordingly, independent Claim 14 patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claim 14.

Dependent Claims 15-21 are also allowable at least for the reasons above regarding independent Claim 14, and by virtue of their dependency upon independent Claim 14. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 15-21.

VI. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

  
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